

Remarks

Claims 1-32 are presently pending in the subject application. Claims 19 and 31 have been amended herein in the manner indicated below. Reconsideration and allowance in view of the above amendments and the following remarks are respectfully requested.

The specification has been amended herein to update the priority data and to address the Examiner's objection to the language of the abstract.

Objection to the Specification

The Examiner objects to the specification on the ground that the term "comprising" in the abstract is a legal term. In response, Applicants have amended the abstract to replace "comprising" with "includes." Accordingly, withdrawal of this objection is respectfully requested.

Rejections Under 35 U.S.C. § 103

The claims stand rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over McGregor *et al.* (U.S. Pat. No. 4,808,381), alone or in combination with any one or more of Roach (U.S. Pat. No. 3,494,201), Sandhage (U.S. Pat. No. 2,906,423), Koch *et al.* (U.S. Pat. No. 5,578,272), and Percarlo (U.S. Pat. No. 4,338,764). Applicants respectively traverse these rejections for the reasons that follow.

To support these rejections, the Examiner relies upon McGregor for teaching an automated method for removing a fluid substance from a collection device that includes all the steps of claim 1 except pausing movement of the fluid transfer device prior to contacting a fluid substance contained within the collection device and, after drawing the fluid substance into the fluid transfer device, removing the fluid transfer device from the collection device. Similarly, the Examiner concludes that McGregor teaches all the steps of claim 21 except increasing the speed of the fluid transfer device after it has punctured a surface of the cap and, after drawing the fluid substance into the fluid transfer device, removing the fluid transfer device from the collection device. However,

with regard to claim 1, the Examiner contends that it would have been obvious to modify McGregor to include the pausing step, as this would allow the operator to visually confirm that the fluid transfer device has passed through the cap before proceeding with removal of the fluid, and to introduce a removing step after an aliquot has been taken from the vessel. And, with regard to claim 21, the Examiner contends that it would have been obvious to alter the speed of the transfer device to minimize exposure of the operator to fluid or fluid vapor and to include a removing step for removal of pipettes which have become defective during the process of removing fluid from the vessel. Applicants respectfully submit that the Examiner's patentability contentions are predicated on a misinterpretation of the construction of McGregor's device and its method of operation.

What McGregor actually discloses is a transfer device (12) that is used in combination with one or more fluid suction members (14, 14') to transfer a material or different fractions (20, 20a) from a tubular receptacle (10). The transfer device (12) is cap-like in configuration and has a cannula (30) which pierces a closure (18) on the vessel (10), thereby providing an opening to the atmosphere for the inside of the receptacle (10). *See* McGregor at col. 4, lines 14-48. The transfer device (12) has a disk-like portion (34) that limits downward movement of the transfer device (12). *See* McGregor at col. 4, lines 20-24, and Figures 1 and 2. Although the transfer device (12) penetrates the closure (18), it does not contact a fluid substance contained within the receptacle (10) and, accordingly, it does not draw a fluid substance for removal from the receptacle (10), as is required by the presently claimed invention. (The transfer device (12) of McGregor further lacks means for drawing a fluid substance.) Instead, the fluid suction members (14, 14') are passed through the hollow cannula (30) of the transfer device to access the contents of the receptacle (10). McGregor does not teach or suggest that the fluid suction members (14, 14') can be used to pierce the closure (18) and, if such were possible, there would be no need for McGregor's invention.

Unlike McGregor, the claimed methods require that the fluid transfer device used to draw and remove a fluid substance from a fluid-holding vessel is the same fluid transfer device used to

puncture a surface of an associated cap. Claims 3 and 23, which depend from claims 1 and 21, respectively, further specify that the fluid transfer device of each of the recited steps is a plastic pipette tip. To suggest that the claimed methods for accessing the contents of a fluid-holding vessel and that of McGregor are equivalents would require dispensing with an essential component of McGregor's method, the use of the transfer device (12) to puncture a closure (18) and, thereby, provide a conduit for a suction member (14, 14') to access to the contents of a vessel (10). *See In re Ratti*, 123 USPQ 349, 352 (CCPA 1959)(the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference]”).

For these and other reasons, Applicants submit that McGregor does not provide a *prima facie* case of obviousness when considered alone or in combination with any of the other cited references. Accordingly, withdrawal of the Examiner's patentability rejections is respectfully requested.

Rejection Under 35 U.S.C. § 112

Claims 19 and 31 stand rejected by the Examiner under 35 U.S.C. § 112, second paragraph, as being indefinite for their use of trademarks in the claims. References to “GORE-TEX® fabrics” in the claims have been deleted. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Based on the amendments and remarks, Applicants submit that the presently pending claims are in condition for allowance and notice to that effect is hereby respectfully requested.

Reply Under 37 C.F.R. § 1.111
Date: December 20, 2007

Serial No. 10/763,449
Atty. Docket No. GP106-11.DV4

No fee is believed due in connection with this Reply. If Applicants are mistaken, then please charge any amounts due to Deposit Account No. 07-0835 in the name of Gen-Probe Incorporated.

Respectfully submitted,

Date: December 20, 2007

By: Charles B. Cappellari/
Charles B. Cappellari
Registration No. 40,937
Attorney for Applicants

GEN-PROBE INCORPORATED
Patent Department/Mail Stop #1
10210 Genetic Center Drive
San Diego, California 92121
PH: 858-410-8927
FAX: 858-410-8928